

#16 / a w/ Exhibits + Cert of Service

**BILL L. DAVIS and JESSE S. WILLIAMSON**

§  
§  
§  
§  
§ Group Art Unit: 2854

Examiner: S. Funk  
J. Hilten

A circular black ink stamp from the Office of Intellectual Property (OIPE). The text "OIPE" is at the top, "JC65" is at the top right, "APR 07 2000" is in the center, and "PATENT &amp; TRADEMARK OFFICE" is at the bottom.

For: **COMBINED LITHOGRAPHIC/  
FLEXOGRAPHIC PRINTING  
APPARATUS AND PROCESS**

## RECEIVED

APR 1 7 2000

TECHNOLOGY CENTER 2800

[illegible]

In response to the Office Action dated February 8, 2000 (mailed February 9, 2000), a response to which is due by grant of reissue applicants' letter petition under Rule 1.136(b) no later than April 9, 2000<sup>1</sup>, reissue applicants amend their specification in columns 3 and 4 as requested by the Examiner, amend claims 12, 19-20, 22, 44-46, 49, 53, 55, 57-58, 60, 62-63, 65, 72, 78, 82, and 85-87, traverse the objections and rejections made by the Examiner, submit an Amended cut-up specification and Supplemental Reissue Declaration, as follows:

## 2

As requested by the Examiner, please amend the specification as follows:

At col. 3, line 59 of the cut-up specification, correct the spelling of "flexographic". The specification at col. 3, lines 53-59 now reads:

A like situation occurs with the printing of slurry-type materials such as "scratch-n-sniff" materials which is a liquid vehicle containing an encapsulated essence. Such liquid vehicles, because of the nature of the slurry, must be printed with a

<sup>1</sup> See DECISION ON REQUEST under 37 CFR §1.136(b), March 9, 2000.

flexographic process because the anilox roller can supply greater amounts of ink to the [flexo] flexographic plate on the plate.

At col. 4, line 47, delete "image".

At col. 4, line 49, insert after "the" the following: .... receptive surface of the copy web or succession of copy sheets on the ....

The specification at col. 4, lines 46-51 now reads:

Whenever a station is used for flexographic printing a flexographic plate [image] is placed on the blanket cylinder for receiving the liquid vehicle and transferring the liquid vehicle to the receptive surface of the copy web or succession of copy sheets on the impression cylinder for printing. Anilox roller is associated with the flexographic plate for supplying the liquid vehicle which may be an aqueous based vehicle

#### In the Claims

Please amend original patent '363 claims 12, 19-20 and 22 as follows:

12. (Amended) Apparatus for creating a combined lithographic/flexographic printing process comprising:

a substrate;

a plurality of successive printing stations for printing color images on the substrate in a continuous in-line process;

at least two successive ones of said printing stations being flexography stations and comprising:

(1) a supply of liquid coating;

(2) a plate cylinder associated with a blanket cylinder, said plate cylinder having a flexographic plate thereon;

(3) an anilox roller associated with said liquid supply coating and said plate cylinder for delivering said liquid coating to said flexographic plate to form an image for transfer to said blanket cylinder;

09315795-052099

A

(4) an impression cylinder holding said substrate for receiving said liquid coating image transferred from said blanket cylinder and printing said image on said substrate[.];

said at least two flexography stations printing the same liquid coating image in sequence and in superimposed relationship; and

at least one offset lithographic printing station [for] receiving said substrate and printing over said liquid coating image.

19. (Amended) Apparatus as in claim 17 wherein at least one of the said colored ink images [are] is formed with a waterless [inks] ink.

20. (Amended) Apparatus as in claim 17 further including an air dryer adjacent to said impression cylinder for drying the colored flexographic ink image transferred to said substrate before said additional colored ink images are printed thereon.

22. (Amended) Apparatus as in claim 17 wherein said colored flexographic ink image and said lithographic colored ink images are printed as solid colors and/or with halftone printing plates in sequence and in registry in said successive printing stations to produce said multicolored image on said substrate.

*(N.E.) Shouldn't the whole claim be underlined?*  
Please amend the following claims first presented in this reissue application:

44. (Amended) Apparatus for a combined lithographic/flexographic printing process comprising:

a substrate;

a plurality of successive printing stations for depositing a

series of [thin, controlled layers] images on one side of a substrate in a continuous in-line process;

one of said stations comprising a flexographic printing station for printing a liquid vehicle image on said substrate using a flexographic process; and

at least one of said successive printing stations being a lithographic printing station;

whereby said substrate is printed on top of or on the opposite side of that previously printed at at least one of said successive lithographic printing stations using the lithographic process in said continuous in-line process.

45. (Amended) Apparatus as in claim 44 wherein at least one of said [thin, controlled layers] images at the flexographic station is a coating material.

46. (Amended) Apparatus as in claim 44 wherein at least one of said [thin, controlled layers] images at one of the lithographic stations is an ink.

49. (Amended) [The] An apparatus [of claim 44] for a combined lithographic/flexographic printing process comprising:

a plurality of successive printing stations for depositing a series of [thin, controlled layers] images on a substrate in a continuous in-line process;

one of said stations comprising a flexographic printing station printing an aqueous-based vehicle on one side of the substrate using the flexographic process to form a metallic coating image;

A<sup>5</sup>  
(con)  
003146 05009  
060250 99.5760

a suspended metallic material being included in said aqueous-based vehicle; and

at least one of the successive printing stations comprising an offset lithographic printing station printing a color image on top of the aqueous-based vehicle or on the opposite side to that previously printed using the offset lithographic process in said continuous in-line process.

53. (Amended) Apparatus for creating a combined lithographic/flexographic printing process comprising:

a plurality of successive printing stations for depositing a series of [thin, controlled layers] images on a substrate in a continuous in-line process;

one of said stations comprising a flexographic printing station for printing a first color image using the flexographic process; and

at least one of the other successive printing stations comprising an offset lithographic printing station for printing a second color image on the reverse side of the substrate of the first color image using the offset lithographic process in said continuous in-line process.

55. (Amended) Apparatus for creating a combined lithographic/flexographic printing process comprising:

a substrate;

a plurality of successive printing stations for depositing a series of [thin, controlled layers] images on a substrate in a continuous in-line process;

at least one of said printing stations being flexographic

stations and comprising:

- (1) a supply of liquid coating;
- (2) a plate cylinder associated with a blanket cylinder, said plate cylinder having a flexographic plate thereon;
- (3) an anilox roller associated with said liquid supply coating and said plate cylinder for delivering said liquid coating to said flexographic plate to form an image for transfer to said blanket cylinder;
- (4) an impression cylinder for receiving said liquid coating image transferred from said blanket cylinder and printing said image on one side of said substrate; and

at least one offset lithographic printing station for receiving said substrate and printing on top of or on the opposite side to that previously printed.

57. (Amended) Apparatus as in claim 56 further including an air dryer associated with each [of said] impression [cylinders] cylinder on [said flexography stations] each flexographic station, said air dryer having sufficient air velocity for drying said liquid coating before the substrate is transferred to the successive printing station in said continuous in-line process.

58. (Amended) Apparatus for a combined lithographic/flexographic printing process comprising:

a plurality of successive printing stations for depositing a series of [thin, controlled layers] images on a substrate in a continuous in-line process, said printing stations including both lithographic and at least two flexographic printing stations;

a blanket cylinder at at least a first one of said

flexographic printing stations;

flexographic ink-providing means at the other of said flexographic printing stations for applying a flexographic ink to said blanket cylinder to form an image on one side of a substrate;

a substrate for receiving said flexographic ink image transferred from said blanket cylinder; and

at least one subsequent lithographic printing station in said in-line process for receiving said image printed substrate and printing an additional colored ink image on said substrate on top of said flexographic ink image or the opposite side to that previously printed using offset lithography.

60. (Amended) Apparatus for a combined lithographic/flexographic printing process for printing a multicolored image comprising:

a plurality of successive printing stations for depositing a series of [thin, controlled layers] images on a substrate in a continuous in-line process, said printing stations including both lithographic and flexographic printing stations;

at least one of said flexographic printing stations having:

(1) a plate cylinder and a blanket cylinder, said plate cylinder including a flexographic plate having an image thereon for transferring a flexographic color ink image to said blanket cylinder;

(2) an etched anilox roller for applying a flexographic color ink to said flexographic plate on said plate cylinder;

(3) an impression cylinder in ink-transfer relationship with said blanket cylinder for transferring said flexographic color

ink image from said blanket cylinder to one side of said substrate;  
and

at least one of said succeeding printing stations being a lithographic printing station using offset lithography for printing additional colored ink images on top of said flexographic ink image or on the opposite side to that previously printed.

62. (Amended) Apparatus as in claim 60 wherein at least one of said colored ink images [are] is formed with a waterless [inks] ink.

63. (Amended) Apparatus as in claim 60 further including an air dryer adjacent to said impression cylinder for drying the colored flexographic ink image transferred to said substrate before said additional colored ink images are printed thereon.

65. (Amended) Apparatus as in claim 60 wherein said colored flexographic ink image and said lithographic colored ink images are printed as solid colors and/or with halftone printing plates in sequence and in registry in said successive printing stations to produce said multicolored image on said substrate.

72. (Amended) A method of combining lithography and flexographic printing in a continuous in-line process comprising the steps of:

providing a plurality of successive lithographic/flexographic printing stations for depositing a series of [thin, controlled layers] images on a substrate;



printing an image as one of said thin controlled layers on one side of said substrate at at least one of said flexographic stations;

transferring said printed substrate to at least one subsequent printing station in said continuous in-line process; and

printing an image on the reverse side of said substrate having said flexographic ink image, at at least one of said other subsequent lithographic printing stations with an offset lithographic process in the continuous in-line process.

*depends on what claim? →* 78. (Amended) A method as in claim [77] further including the step of printing an aqueous-based coating over said slurry.

82. (Amended) A method of combining lithography and flexographic printing in a continuous in-line process comprising the steps of:

(1) providing a plurality of successive printing stations for depositing a series of [thin, controlled layers] images on a substrate in said in-line continuous process;

(2) utilizing an anilox roller to transfer a liquid ink as one of said [thin controlled layers] images to a flexographic plate image at at least one of said printing stations;

(3) printing said liquid ink from said flexographic plate image to one side of a substrate;

(4) transferring said printed substrate with said liquid ink image to a subsequent printing station in said in-line printing process;

(5) repeating steps (2)-(4) at subsequent printing stations in said in-line process to achieve a desired opacity ink image on the one side of said substrate; and

(6) printing an ink pattern on the reverse side of said substrate using an offset lithographic process.

85. (Amended) A method of combining offset lithography and flexography using a plurality of successive printing stations in a continuous in-line process, at least one of said stations comprising a flexographic printing station for printing an image on said substrate using a flexographic process, comprising:

(1) printing an image at one or more of said printing stations on a substrate using an offset lithographic process;

(2) transferring said image printed substrate to an additional and flexographic printing station and printing at said additional and flexographic printing station a coating on all or part of said image on said substrate;

(3) transferring said substrate to one or more additional printing stations for printing the reverse side of the said substrate; and

(4) printing an image on said reverse side of said substrate at one of such one or more printing stations using an offset lithographic process in the continuous in-line process.

86. (Amended) Apparatus for a combined offset lithographic and flexographic printing process comprising:

(1) a substrate;

(2) a plurality of successive printing stations for depositing a series of [thin layers of materials] images selected from a group consisting of lithographic and flexographic inks, coatings and slurries on one or both sides of a substrate in a continuous in-line process;

(3) at least one of said stations comprising a flexographic printing station for printing [one of said flexographic materials] an image on said substrate using a flexographic process;

(4) at least one of said successive printing stations being an offset lithographic printing station whereby said offset lithographic printing station is used to deposit one of said lithographic materials on either side of the said substrate in the continuous in-line process;

87. (Amended) Apparatus for a combined offset lithographic/flexographic printing process comprising:

a plurality of successive printing stations for printing images on a substrate in a continuous in-line process, said printing stations including both offset lithographic and flexographic printing stations for depositing lithographic inks, and one or more flexographic inks, coatings and slurries on said substrate, whereby said lithographic inks, and one or more flexographic inks, coatings [or] and slurries may be printed successively on one or both sides of said substrate in the continuous in-line process.

### Remarks

Applicants undersigned attorney or record received the Office Action dated February 8, 2000, actually mailed February 9, 2000. Pursuant to the Examiner's requests, Applicants have amended their specification in the paragraphs at col. 3, lines 53-59 and col. 4, lines 46-51 of their specification and claims 12, 19-20, 22, 44-46, 49, 53, 55, 57-58, 60, 62-63, 65, 72, 78, 82, and 85-87.

As the examiner has requested that Claim 49 be made independent, an extra fee of \$78.00 is submitted herewith.

The draftsman has made objections to the drawings, which are no more than copies of the drawings of the issued patent. A letter to the Patent Office Draftsman requesting transfer of the drawings from the '363 patent file history is submitted herewith under separate cover. The decision of the prior draftsman as to the adequacy of the drawings should be accepted. Ex Parte Hampton, et al., 35 U.S.P.Q. 169, 170 (Bd., App., 1937).

### **I. The Reissue Declaration**

Reissue Applicants have indicated their U.S. nationality (37 C.F.R. §1.63(a)(3)) and have supplemented their Reissue Declaration, submitted on even date. Applicants traverse the rejection of their claims under 35 U.S.C. §251, as the existing Declaration already conformed to new 37 C.F.R. §1.175(a), amended in late 1997, that reissue applicants no longer have to indicate how each error arose, when it was discovered, and that in the absence of correction the patent is fatally defective, etc., (formerly required of old 37 C.F.R. §1.175(c)-(f)):

"(a) The reissue oath or declaration in addition to complying with the requirements of §1.63, must also state that:

- (1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant."

37 C.F.R. §1.175(a) (December 1, 1997). Applicants Reissue Oath executed May 20, 1999 stated adequately:

"Petitioners verily believe that because of what might be deemed errors on the specification and claims of U.S. Pat. 5,630,363, that said '363 patent might be inoperative or invalid ...

"Petitioners declare that all of these errors sought to be corrected arose through their unfamiliarity with U.S. patent practice, and/or through inadvertence, and were all without any deceptive intention. Petitioners seek to correct these errors through amendments to their specifications and claims, and endorse the Amendments set forth in Exhibit "A" hereto."

37 C.F.R. §1.175 (December 1, 1997) required nothing more. Applicants, however, supplement their declaration in ¶2 with the language suggested by the Examiner, haec verba.

The Examiner suggested at the top of page 3 that "three separate declarations" might be combined. Only the Reissue Declaration is a declaration by the inventors for which Rule 175 applies. It is a required document to be submitted by the reissue applicant. 37 C.F.R. §1.172(a), first sentence and 37 C.F.R. §1.175 (December 1, 1997). Reissue applicants had, on the filing date, submitted through counsel a Memorandum entitled "Application for Reissue of U.S. Pat. 5,630,363 under 35 U.S.C. §251 and 37 C.F.R. §1.171", which is in the form of information and argument that put the objects of the reissue application in some perspective. The Declaration and Power of Attorney is a document by the assignee of reissue applicants. Documents such as these – in former times called "Assent of Assignee to Reissue" is required separately by the Rules . 37 C.F.R. §1.172(a), last sentence. Applicants respectfully submit that combining the three documents would be unwieldy and improper.

## **II.**

### **Objections to the Specification**

Reissue applicants note the Examiner's objections to the Specification at col. 3, line 59 and col. 4, lines 46-49. Stenographical amendment has been made to correct the first objection,

60367 342729

and the second objection is cured by rewriting the sentence involved, consistent with the existing language at col. 3, line 13-18 of the cut-up specification and avoiding new matter. Amendments are made in conformance with 37 C.F.R. §1.121(b)(1).

### III.

#### **Rejections Under 35 U.S.C. §112, 2d par., or 37 C.F.R. §1.75(a)**

Correction of Claims 12, 19-20, 22, 44-46, 49, 53, 55, 57-58, 60, 62-63, 65, 72, 78, 82, and 85-87 are made in the format suggested/hinted at by the Examiner. The typographical errors in Claim 57, line 3 of "flexography" and Claim 78, line 1 of "77urther" are corrected.

The term "thin controlled layers" (and the like) on Claims 44-46, 49, 53, 55, 58, 60, 82 and 86 are changed with the term "images" which appears often in the specification, although the terms are equivalent. **See Supplemental Declaration of Raymond J. Prince, ¶10, Exhibit A** hereto. Claim 12, subparagraph (4) has been corrected consistent with the clarification of the specification at col. 4, lines 46-51 above. Claim 49 has been put in independent form, as suggested by the Examiner, and an additional fee is attached. The alleged ambiguities in Claims 19, 20, 21 and counterpart perfection claims 62, 63 and 65 have been corrected. Claim 85 has been corrected to include a specific recitation of flexography in the body of the claim. The alleged disparity and apparent ambiguity in Claim 87 of "and" versus "or" has been eliminated. Claim 57 has been amended to be singular concerning "each flexographic station" to remedy the antecedent basis rejection.

Accordingly, all existing claims 1-87 are seen to be in conformance with 35 U.S.C. §112, 2d par. and 37 C.F.R. §1.75(a).

### IV.

#### **Rejection of Claims 42-87 Under 35 U.S.C. §112, 2nd par and 35 U.S.C. §251, fourth par.**

Claims 42-87 are, indeed supported by the specification, not only with respect to the mention of perfection at col. 2, lines 54-55, but the teaching of "over" in the specification at col. 4, lines 29 and 43. As stated by expert Prince in his original declaration testimony:



003475610040

The Examiner confuses the terms "over" – which includes both (a) overprinting – printing on the same side *as previously printed*, and (b) printing on the reverse side, e.g., by tumbling the substrate to be printed. See testimony of Prince, supra. Unlike DeMoore, et al. EP741,025 (which teaches overprinting, but not perfection), reissue applicants teach perfection haec verba at col. 2, line 54 and by the use of "over" at col. 4, lines 38 and 43, col. 6, line 64, col. 7, line 12 and 31, etc. Overcoating is also taught by reissue applicants (col. 5, line 2, col. 5, line 18, col. 7, lines 15-23, even with the words "on top of" (col. 5, line 24, col. 7, line 58). As Prince testifies in his **Supplemental Declaration, Exhibit A** hereto, at ¶¶3-9:

"3. I have received a portion of an office action in the captioned application and understandings dated February 8, 2000, attached hereto as Exhibit A. I have also reviewed reissue applicants claims as filed 1-87, Exhibit B. **For the reasons that follow in paragraphs 4-10 below, I disagree with the examiner's conclusions in Exhibit A, and conclude claims 1-87 are supported by the specification of '363 patent being reissued.**

"4. The terminology of the printing industry has gone through many changes in the past 500 years, it can get a bit complex to the lay person with words having many meanings depending on how they are used.

(A) Perfecting means to print on both sides of the sheet or web in on pass through the press. Most web presses sold today and in the last 20 years are perfecting presses. These presses operate using a blanket to blanket cylinder approach. Therefore every time the word web is used in '363 patent it means a perfecting process.

(B) Press manufacturers will refer to a perfecting press by the number of colors, and where the perfecting unit is. A 6-color press with the perfecting unit between units 2 and 3 would be referred to as a 2 over 4 unit. It can print 2 colors and turn the sheet and print 4 more colors. One can purchase 1 over 5 presses as well as 2 over 2 presses and just about every combination one can think of.

(C) Another way of expressing the above (B), is to describe a 6-color press with a perfecting unit between units 2 and 3 would be to state is as a 2/4 press.

"5. The term "single in-line continuous printing process" in the '363 patent also refers to a perfecting press. A prime example is a web offset press that begins with a roll of paper and ends with a folded signature of final product. It may also refer in a sheet fed



plant to a perfecting press in which unprinted paper is fed into the press and a sheet printed on both sides is delivered. A press that cannot print on both sides in one pass is not a "single in-line continuous printing process".

"6. Based on the above teachings of "perfector", together with the teachings of printing "over" and "single in-line continuous printing process", claims 44-87 of the '363 reissue application are based on a perfecting press as described in '363, and are supported by the teachings of the '363 patent.

"7. The term "overcoating" can be used with a press that does perfect as well as with a press that does not perfect. The term means to apply a material/coating over a previously applied material. Printing "on top of" is synonymous with "overprinting" – printing on the same side of – which is a subset of printing "over" in which the second or downstream unit can also print on the reverse side of the substrate.

"8. In column 4, lines 29 and 43 of the '363 patent, reference is made to printing an image "over" a previously printed image. In column 4, line 38 of the '363 patent overcoating can apply to a perfecting press or a non-perfecting press, the preferred method would be to accomplish this on one pass through the press (a in-line continuous printing process), a perfector. Generally when the term "overcoating" is used in the art, it is used to describe the use of a final coating of a gloss, dull or matt water based or UV coating to improve finish (visual) and or rub resistance.

"9. In reviewing column 7, lines 52-60 of the '363 patent, the language "on top of" is only describing one way printing works, using reissue applicants' process. This is the same on a "perfecting" or non-perfecting press." (Emphasis Prince)

As indicated by expert Prince, reissue applicants' teachings are versatile and concerning the combined process.

The Examiner erroneously points to a teaching within DeMoore of perfection at col. 3, lines 17-20. "As used herein, the term 'processed' refers to various pointing materials which may be applied to either side of a substrate . . ." It is respectfully submitted that "either" side does not mean both sides. Moreover, the remainder of DeMoore's teachings pertain to overprinting, which is not perfection. Note DeMoore 74/1025A2 at col.9, line 13, col. 9, line 50, col. 9, line 56, col. 10, line 23, etc. Simply put, DeMoore does not teach perfection, he teaches away from it. As expert Prince testifies in his **Supplemental Declaration Exhibit A** (¶11, lines (1)-(3)):

042596 063099

"11. I have also been asked to review the process aspects of EP 741,025A2 ("025") in conjunction, and rejections, of claims 1-87 based on anticipation (35 U.S.C. sec 102) and obviousness (35 U.S.C. sec 103) by the examiner, in the same office action, the pertinent portion attached hereto as Exhibit C. I understand that the examiner believes the invention of reissue claims 1-6, 9-20, 22-25, and 28-38 are taught by the '025, i.e. "anticipated", and the remaining claims "obvious". I understand a publication is anticipatory if it puts one of average skill in the art in possession of the claimed invention at the time of (filing date) of the claimed invention. I understand that a referral makes a claims invention obvious if the claimed invention as a whole was obvious to perform or to do as of the filing date of the claimed invention. **I strongly disagree with the examiner and I found claims 1-87 cannot be anticipated or made obvious by the '025 even if it is prior art (which I cannot see how, the '025 was published in late 1996 and the filing date of the '363 is in 1995).** In examining EP O 741 025 A2, I conclude:

- (1) "There is no reference to perfecting in the '025;
- (2) "The '025 application refers to overprinting which is not perfecting, and which is not synonymous with printing over;
- (3) "There is no mention of a single in-line continuous printing process; (Emphasis Prince)
- (4) "The '025 application expounds the cantilever approach and its design rather than a process – the cantilever design has been in use through out history, and I find it hard to believe that valid cantilevered apparatus claims for the particular cantilever disclosed could be an issue in any industrial country;
- (5) "Cantilevered coaters, as described in the '025 and variations thereof, was traditionally placed at the end of a presses as of 1995, not between units."

The Examiner dismisses Prince's first expert testimony because Prince does not provide a written exhibit as to "over". Prince's expert sworn testimony working in the printing industry with many clients, including reissue applicants' assignee. See Prince, Original Declaration. If the Examiner wishes to challenge this testimony, it is respectfully submitted such challenge should be made under oath, pursuant to 37 C.F.R §§1.104(c)(3) and 1.104(d)(2). Otherwise, the

dismissal of the expert testimony is seen as, by law, insufficient, and the rejection should be withdrawn.

V.

**Rejection of Claims 1-6, 9-20, 22-25 and 28 Under  
35 U.S.C. §102(e) over DeMoore, et al. U.S. Pat. 5,960,713 or EP 741,025 A2**

The rejection of the aforementioned claims is respectfully but strongly traversed for each of the reasons:

A.

**The Rejection is Non-Statutory**

Attached hereto is a copy of U.S. Pat 5,960,713 (Exhibit B). Like earlier issued U.S. Pats. 5,598,777 and 5,651,316, the '713 is a creature of four applications filed on the identical text and drawings on October 2, 1995, subsequent to reissue applicants' filing date.

The only "CIP" material which appears to us was added to the October 2, 1995 date appears at col. 16, lines 18-41.

*More important, an examination of the application on which it depends –unissued Serial Number 08/435,798 (**Exhibit C** hereto) shows that entirely different inventions are involved – the '713 teaching claiming an in-line flexographic and lithographic apparatus while the 08/435,798 is directed to an "add-on", cantilevered configuration, the type of which is old in the art. See **Supplemental Declaration of Prince**, ¶¶11(4) and 11(5), **Exhibit A** hereto. The figures of each of Exhibits B and C are different as is the text. *There is very, very little overlap in the '713 patent background and objects from col. 1, line 30 through col. 4, line 28 with Serial Number 08/435,798 (highlighted yellow in '713 **Exhibit B**) and the rest was added on October 3, 1995 (highlighted pink) or the 1998 CIP, i.e., Col. 16. There is no overlap in the drawings order crypton of the preferred embodiment. The teachings of '713 / '777 / '316 and the Serial No. 08/435,798 are directed to apples and an orange.**

And that brings us to another point. DeMoore '713 falsely and belatedly in late 1998 claimed the benefit of the filing date of Serial No. 08/435,798 at a time Serial No. 08/435/798 was rejected and was on appeal before the Board of Appeals of Interferences. In MPEP §201.11 (note last section) does not require a PTO examiner to compare specifications of an applicant to ascertain correctness of a date claimed under 35 U.S.C. §120. This can lead to invalidity. See Akzona, Incorporated v. Pennwalt Corporation, 570 F. Supp. 1097 (D. Del. 1983), affirmed, 740 F.2d 1573, 1578-1579 (Fed. Cir. 1984). Comparison of Exhibits B and C indicates to any competent lawyer that any §102(e) rejection based on the '713 patent must be withdrawn, as the '713 is very clearly not entitle to the May 4, 1995 filing date. A copy of the district court Akzona case is attached hereto as **Exhibit D**.

EP 741,025 is likewise unavailable, on its face EP 741,025A2 is not a foreign patent under the law. Most importantly, EP 741,025A2 did not publish until November 6, 1996, and is available as a reference under 35 U.S.C. §102(b) only a year after its publication. See In re Hilmer, 359 F.2d 859, 149 USPQ 480 (CCPA 1966). A European published patent application based on a US priority document is not a U.S. patent under 35 U.S.C. §102(e).

#### **B.**

#### **DeMoore et al. and PRI Derived Whatever Elements of the '363 Process Disclosed in the '025 Application Invention Came from Reissue Applicants**

Under separate cover in a document entitled **Applicants Memorandum Concerning the Prior Art and Their Position on Patentability ("Memorandum")**, Applicants submit the attached declarations of (1) EP 741,025 and Ser. No. 08/435,798 applicant **Bird**, former employee of DeMoore, former DeMoore employee Steven **Baker**, and Heidelberg U.S.A. employee Scott **Brown**, and former PRI President Steve **Garner**. As is indicated in the sworn testimony of Baker and Bird, reissue applicants told PRI employee Baker about reissue applicants invention during a restaurant meeting in July 1994. Baker Decl. ¶¶4-7 (**Memorandum Exhibit A**) and Bird Decl. ¶10 (**Memorandum Exhibit B**). The parties had settled a previous litigation in October, 1993, and reissue applicants assignee agreed in that settlement to give DeMoore's company some business. Reissue applicants chose to have some

660377 96 47 E 44

tests conducted at DeMoore's place of business in the fall of 1994 to check out a "rack-back" type add-on device. Baker Decl. ¶¶8-9, **Memorandum Exhibit A**; Bird Decl. ¶¶ 10-13, **Memorandum Exhibit B**. As testified by Bird, one of the '025 applicants, and according to his testimony the only PRI employee familiar with flexography (Bird Decl. ¶¶10, 12-13 and 6, the basic process cam from reissue applicants):

"I became aware from Steven Baker, one of PRI's salesmen, upon his return in July 1994 from Atlanta, Georgia, of a meeting between Steven Baker, Jesse Williamson and Bill Davis of WPC. Steven Baker told me of a July 1994 meeting in an Atlanta restaurant in which Davis and Williamson told him (Baker), in confidence, of Davis and Williamson's intent to improve the so-called "WIMS" metallic printing process of WPC, U.S. Patent No. 5,370,976 ([Bird] Exhibit 13), of which at the time I had some familiarity with the process, but not a lot. Baker told me in July 1994 that WPC had already committed orally to purchasing dryer equipment from PRI for the line of Heidelberg printing presses, and that Baker had shown Jesse Williamson and Bill Davis a PRI-constructed HV interstation dryer at James River carton printing plant in Newnan JB, Georgia, and that Baker had been told of a pending WPC patent application for the "WIMS" process. Baker told me that as part of these discussions, they confided in Baker that they wanted to use flexography at a station they designated "up-stream" -- perhaps even the first station -- of one or more offset lithography presses that they would receive from Heidelberg. Baker mentioned to me at the time in July 1994 that they mentioned several ways in which this could be done -- most preferably, a retractable or "rack-back" mechanism, which would have to be modified for "upstream" use. Baker told me that with respect to the "rack-back" option told him by Davis and Williamson, they would have to have the retractable mechanism have an anilox roller, a chambered doctor, and the use of state-of-the-art flexographic plates. Baker told me that Davis and Williamson indicated they had just seen the use of some of these flexographic (BASF) plates in Germany, and that a number of companies sold high-resolution plates which would work in their new process. Baker told me that Davis and Williamson inquired whether PRI was interested in supplying these types of "rack-back" or retractable mechanisms, and that he (Baker) told Williamson and Davis of the PRI "rack-back" and provided a brochure, [Bird] Exhibit 10. Effertz Tool Company, Franklin Lakes, New Jersey, made these "rack-backs" for me while at Birow, Incorporated, and Effertz continued to make these "rack-backs" for PRI for the few units PRI sold when I brought the technology to Dallas.

"Steve Baker also told me on his return to Dallas in July 1994 that Davis and Williamson wanted some experiments run at PRI using my "rack-back" (note again brochure, Exhibit 10). I recall such

experiments at PRI conducted in the fall of 1994. These tests were done on PRI's two-color Heidelberg R&D press utilizing an existing "rack back" coater of my design at the end of the press, at the direction of WPC, with WPC supplying most of the flexographic inks and the flexographic plates for the experiments. The tests were chiefly designed to determine the resolution that was possible with the PRI coater, and supplied plates and coatings. No one-pass tests of the claimed '363 process were done in the fall at PRI. In fact, to the best of my knowledge, no tests were ever conducted at PRI of the '363 invention, only at WPC. In fact, to the best of my knowledge, no off-line simulated tests (flexography done first with a second pass of performing offset lithography in a pass-through) were ever performed at PRI. I never collaborated with Bill Davis or Jesse Williamson or anyone else at Williamson concerning the '363 invention in 1994 or 1995. Again, PRI, to the best of my knowledge, does not have any late 1994 or early 1995 record, notebooks, e-mails or memoranda concerning any conception by PRI of the '363 claimed invention.

"I suggested that my colleagues start working toward an acceptable flexographic printer coater for use with the Davis-Williamson '363 process. In the late fall of 1994, pursuant to my recommendations, PRI did start working on what was termed in-house as the "Rendleman coater," the first prototype being a cantilevered, "short-arm" device that would fit on an end-of-press Heidelberg-manufactured coating tower of the first Heidelberg press to arrive at Williamson - the so-called "7 color Heidelberg CD." The purpose of our development of the device was clear: we did this to try to get all of WPC's business. We had no firm orders from them for this equipment. That prototype was actually not installed at WPC until late February 1995.

"Accordingly, when I reviewed PRI's complaint, I find no important factual merit to it whatsoever. The invention of the '363 patent has never been installed or used outside of WPC. The "Rendleman coater" was developed at the suggestion of Bill Davis and Jesse Williamson for WPC. Neither Ron Rendleman or I have ever developed the '363 process, let alone Howard DeMoore. Had PRI invented the process, PRI would never have taken prototypes outside the offices of PRI or told a customer about it without detailed secrecy agreements. *Moreover, in my opinion, PRI had no motivation to come up with the process invention because it did not utilize the WIMS process out of which I believe the '363 patent originated. To the best of knowledge, no one at PRI ever told the '363 invention to Davis and Williamson - the reverse I know occurred in July 1994. PRI did not even have the facilities to reduce the '363 invention to practice - even by simulation. If PRI had the capability to use or to simulate the '363 process, the 1995 brochure would have been printed by the '363 process. The brochure was not. I know intimately the details of the development of the "Rendleman coater" in 1994-1995, had numerous discussions on a week-to-week basis with*

*Rendleman, kept DeMoore informed as to the progress of its development and the installation s of the "short term" (late February 1995) and long-arm devices, and attended the few experiments in the fall of 1994 and the few meetings in 1995 where employees of the two companies met. No experimental or developmental work - no collaboration- occurred between PRI and WPC. Howard DeMoore was never involved in the conception or development of the interstation "Rendleman coater" - he was virtually never in PRI's offices. To the best of my knowledge, the '363 invention is the genius of Jesse Williamson, who is a visionary, and Bill Davis whose printing process experience made it possible to bring it about.*

Contrary to the allegations in the Complaint, Exhibit 4 [hereto], Howard DeMoore did not conceive, invent, reduce to practice, or develop the '363 invention, or any individual or team at PRI" Bird Decl., ¶¶ 24-25 (Emphasis supplied).

In discussions in January 1995, reissue applicants told PRI that they would file a process patent application on their process invention. Baker Decl. ¶10; Bird Decl. ¶14. Reissue applicants simulated the invention by a flexography pass through first, followed by offset lithography, in Germany in January 1995 and again in the USA in the latter part of March 1995 - which Bird attended as a guest of applicants -- , for which the applicants received recognition in the industry and won a prize. The test in Germany had been planned since the previous fall, See Brown Decl., ¶¶3-6. Moreover, reissue applicant told Brown of Heidelberg U.S.A. of the invention as far back as July, 1994. Brown Decl. ¶2, **Memorandum Exhibit C**.

**Bird** also testified that pursuant to a series of meetings after July 1994, starting on August 18, 1994 and ending in late fall of 1994, reissue applicants told Bird of the process details of reissue applicants process that ultimately showed up in the '025 patent application. **Suppl. Bird ¶¶2-5, 9** (Emphasis supplied), **Memorandum Exhibit D**. Even former PRI President **Garner's (Memorandum Exhibit E)** testimony is not inconsistent with Bird's - the PRI employees didn't start active development on the cantilevered device until December 1994, and none of the PRI employees at the time claimed inventorship of the process.

Hence, Bird, DeMoore and PRI derived whatever portions of cantilevered patent EP 741,025A2 pertains to reissue applicants process or Serial No. 08/435,798 from reissue applicants.

C.

**Even were it Prior Art EP 741,025 A2 or Serial No. 08/435,798  
Does Not Put the Artisan in Possession of Claims 1-6, 19-20, 22-25 or 28-38**

Over 90% of the EP 741,025 A2 apparatus teaching is directed to the cantilevered apparatus claimed – not the process.

Even ignoring the fatal defects of each of each description / utility and the failure to incorporate the WIMS '976 patent, the rest is far too pithy to place the applicant in possession of applicants process invention. Most revealing is that DeMoore EP 741,025 teaches use of the cantilevered unit between offset lithography units or traditionally, at end of press (See col. 2, lines 6-9. Only at col. 2, lines 40-45 does he mention the possibility of a flexography unit tested prior to offset lithography. Nowhere does he teach the remarkable and surprising benefits of reissue applicants' invention.

That should come as no surprise. The reason is that DeMoore and PRI had not simulated the invention or reduced it to practice by May 4, 1995 at PRI. See, Bird Decl. ¶¶13-16. PRI's only exposure to the benefits of the invention were simulations conducted by reissue applicants at reissue applicants' employer in March 1995, attended by PRI's Bird. Bird Decl. ¶16. DeMoore's lack of instruction to do the invention coupled with no teaching of the surprising results leads to the inevitable conclusion that as of May 4, 1995, DeMoore was not in possession of the claimed invention. In re Donohue, 766 F.2d 531, 266 USPQ 619 (Fed. Cir. 1985).

That also should not be surprising. Reissue Applicants' 363 process invention was the culmination of years of research involving specialty offset lithographic priority applications of metallic links. Specifically, the invention of the '363 patent was precipitate by reissue applicants' awareness that the results achieved by their assignee Williamson Printing Corp. in the early 1990s in reproducing on a substrate, e.e., paper, an image incorporating certain metallic inks were not the ultimate results desire for particular uses<sup>2</sup>. In the offset lithographic process,

<sup>2</sup> Specifically, the aesthetic results achieved by the Williamson Integrated Metallic Systems ("WIMS") process, U.S. Patent 5,370,976, incorporated by reference in the instant application (col. 8, lines 8-12), which while clearly far superior to conventional four-color process printing of subject matter containing metallic images, was deemed by reissue applicants as subject to still further improvement, especially involving the application of metallic golds and silvers, which are





- 26-



00314796 "052099

offset lithographic process cannot be used without the mixing of the aqueous solution with metallic inks which cause a dulling of the image. Further, the above-mentioned double split of the ink film adds to the dulling of the image. Therefore, to achieve desired results, the printing must take place with a flexographic printing machine.

"Thus, liquid opaque coatings or inks such as white colored ink, scratch-and-sniff vehicles, and slurries with metal particles do not achieve desired results when printed in an offset lithographic in-line machines to a separate machine for printing in a separate run.

"Such requirements not only hinder the speed of the printing process but also require additional time and thus increase the cost of the printing.

- 
- 
- 

#### [The Solution]

"The present invention provides for a continuous in-line printing process having a plurality of successive printing stations for printing color images on a substrate. At least one of the stations prints a liquid vehicle image on a substrate with an opaque coating using the flexographic process and at least one of the successive printing stations printing a second color image over the liquid vehicle image on the printed substrate using the lithographic process in the continuous in-line process.

"In the novel invention system, a single in-line continuous printing process is used. One of the stations may print a liquid vehicle image on a substrate that contains a slurry with an encapsulated essence therein utilizing the flexographic process. Another one of the stations may apply an overcoating over the liquid vehicle image on the printed substrate using a lithographic process. Still another of the stations may print an aqueous-based vehicle image including a suspended metallic material therein using the flexographic process to form a metallic coating and thereafter at least one of the successive printing stations prints a color image over the aqueous-based vehicle image using the lithographic offset process in the continuous in-line process.

"Whenever a station is used for flexographic printing, a flexographic plate image is placed on the blanket cylinder for receiving the liquid vehicle and the transferring the liquid vehicle to the impression cylinder for printing. An anilox roller is associated with the flexographic plate for supplying the liquid vehicle which may be an aqueous-based vehicle.

"In addition, in such case, a high-velocity air dryer is associated with the impression cylinder for printing on the substrate is

occurring to assist in drying the ink or liquid vehicle printed on the substrate while it is on or near the impression cylinder, before the substrate arrives at the next successive station for additional printing, or before printing occurs at the next successive station.

"Thus, if a liquid vehicle such as white ink is to be printed, it is printed with a flexographic process which deposits a greater amount of ink on the substrate, the ink is dried with a high-velocity air dryer while the substrate is on or near the impression cylinder and prior to the substrate being received by the next successive station. If desired, at the next successive station the printing of the white liquid vehicle may again take place thus ensuring the desired intensity of whiteness on the substrate. Subsequently, at the next succeeding station the printing of the white liquid vehicle may again take place thus ensuring the desired intensity of whiteness on the substrate. Subsequently, at the next succeeding station a printing may continue at the remaining successive stations.

"Thus, it is an object of the present invention to provide a plurality of successive printing stations for printing color images on a substrate in a continuous in-line process and in which some of the stations print using the flexographic process and other of the stations print utilizing the offset lithographic process.

"It is also an object of the present invention to print an aqueous-based vehicle image including a suspended metallic material therein using the flexographic process at one printing station and at least one successive printing station printing a color image over the aqueous-based vehicle image using a lithographic process in a continuous in-line process or placing an overcoating over the aqueous-based vehicle image using the flexographic process and then printing at successive stations using the lithographic process.

"It is yet another object of the present invention to provide a continuous in-line printing process in which one of the stations prints a liquid vehicle image on the substrate with a slurry containing an encapsulated essence using the flexographic process and at least one of the successive printing stations applies an overcoating over the liquid vehicle image on the printed substrate using the offset lithographic process in a continuous in-line process.

#### The Advantages

"It would be advantageous to have a continuous in-line process in which not only offset lithographic printing could take place but in which, in the same in-line process, liquid printing vehicles including opaque coatings, such as white ink, and slurries containing encapsulated essences or metallic particles could also be printed and dried not only before the printing of the offset lithographic inks but also in which, after the liquid opaque coatings have been applied, an overcoating



encapsulated essence. In another embodiment, at least one of the printing stations prints an image with a water-based liquid vehicle containing suspended particles that are either uniform or nonuniform in size. The suspended particles may be metallic particles up to substantially 16 microns in diameter.

**"The present invention may also use the metallic color printing process as disclosed in commonly assigned U.S. Pat. No. 5,370,976 incorporated herein by reference in its entirety.**

"In one aspect, the novelty of the present invention is to create a flexographic printing stations that can be used at one of a plurality of printing stations in a continuous in-line process and in which, at a subsequent printing station, a lithographic process may be used to print over the liquid vehicle printed by the flexographic station.

"Thus, there has been disclosed an apparatus for a combined lithographic/flexographic printing process that includes a plurality of successive printing stations for printing color images on a substrate and a continuous in-line process and wherein one of the stations prints a first color image using the flexographic process and at least one of the successive printing stations prints a second color image over the first color image using the lithographic process in the continuous in-line process." (Emphasis supplied).

See '363, Col. 3, line 40 - Col. 5, line 28 and Col. 7, line 37 - Col. 8, line 27.

Compare the above with the pithy and far inferior teachings of the '025 patent application concerning reissue applicants' process does not identify the problems, does not unequivocally identify the solution , does not incorrectly reference WIMS '976, does not provide applicants' advantages:

"In some printing applications, offset and smearing are prevented by applying a protective and/or decorative coating over all or a portion of the freshly printed sheets. Various arrangements have been proposed for applying the protective or decorative coating as an in-line operation by using the last printing unit of the press as the coating application unit. However, when such in-line coating is performed, the last printing unit cannot be used to apply ink to the sheets, and can only be used for the coating operation. Thus, while coating with these types of in-line coating apparatus, the process loses the capability of printing its full range of colors since the last printing unit is converted to a coating unit.

"It will be appreciated that the time required to reconfigure a press for coating or non-coating is non-productive and costly. Accordingly, there is a need for an in-line coating apparatus that minimizes the time to clean-up from one printing run and set-up





to the operative position without requiring adjustment or alteration of the printing unit cylinders, it can be used for applying printing ink or coating material to the blanket cylinder of a rotary offset web press, or to the blanket of a dedicated coating unit."

See Col. 1, line 22 - Col. 2, line 9, Col. 2, lines 32-45 and Col. 11, lines 35-49 of the '025. **The '025 patent application is not talking about a problem of dulling, but if anything, relates to two process alternatives to avoiding "offset and smearing", at best. The fact that there are two alternatives indicate the authors didn't understand the problem, let alone the solution. The problem of dulling is not identified, nor is the problem of the time delay of transfer of substrates between offset lithographic presses and flexographic presses where opaque coatings or metallic coatings are involved. One reading the '363 patent, having a knowledge of the WIMS process would therefore know the '363 patent taught the way to eliminate the dulling and lack of speed problems of the WIMS process, while one reading the '025 patent specification would not. Simply put, the '025 teaching concerning the process is nonenabling, fails to incorporate WIMS '976, and furthermore lacked sufficient description of reissue applicants' invention, including its utility, to motivate one of ordinary skill in the art to perform it in May 1995.**

It is fundamental to our patent law that to establish prior invention, there must be evidence that the alleged prior inventors **appreciated** at the time of their work all of the elements of the invention. Standard Oil Company v. Montedison, 494 F. Supp. 370, 2206 U.S.P.Q. 676 (D. Del. 1980), aff'd, Standard Oil Company v. Montedison, 664 F. 2d 356, 212 U.S.P.Q. 327 (3<sup>rd</sup> Cir. 1981). See also, duPont v. Phillips Petroleum, 2 U.S.P.Q. 2d 1545, 1552 (D. Del. 1987), aff'd in part, rev'd in part, 7 U.S.P.Q. 2d 1129 (Fed. Cir. 1988). **Appreciation** is part of each of the patent laws legal concepts of conception and reduction to practice. See, Tilghman v. Proctor, 102 U.S. 707, 711-712 (1881) and Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45 (1923); Heard v. Burton, 142 U.S.P.Q. 97 (C.C.P.A. 1964); Jennings v. Hill, 87 U.S.P.Q. 93 (C.C.P.A. 1950).

Such lack of appreciation for the problems in the prior art, for the advance made by the claimed process and the failure to incorporate the WIMS exhibit that lack of appreciation, and place the artisan reading the '025 specification in mid-1995 in the awkward position of having no motivation whatsoever to try the flexography - first step alternative. See Prince supplemental declaration, ¶¶11(6) and 11(7). *To constitute an anticipatory publication within the meaning of 35 U.S.C. §102(b), or if applicable, 35 U.S.C. §102(e), the invention must be described sufficiently to impact a person with ordinary skill and knowledge of the prior art the information needed to devise the invention without further genuine inspiration or undue experimentation.* See, Seymour v. Osborne, 78 U.S. 516 (1871); and, In re LeGrie, 301 F. 2d 929, 933-934 (C.C.P.A. 1962).

**D.**

**The Akzo N.V. in re Aramid Fibers Case is on all Fours  
With This Process Case, and Both the ITC and the Federal  
Circuit Determined There Was No Anticipation or Obviousness**

On April 18, 1984, E.I. duPont de Nemours and Company filed a complaint with the International Trade Commission under §337 of the Tariff Act (19 U.S.C. §1337) alleging that Dutch respondent Akzo N.V. and two other respondent Dutch companies committed unfair competition by importing into their country aramid fibers competing with Kevlar by a process practiced in Holland, which, were the process practiced in the U.S. would infringe Blades air-gap spinning process U.S. Pat. 3,767,756, and specifically claim 13 of the '756 patent of which the Dutch companies were accused of unfair competition. The investigation was deemed "complicated", and after extensive discovery before the commission, it was revealed that duPont employee Blades received from his supervisor Boettcher the suggestion to use the air gap, and the Boettcher had obtained information about the air gap from a lengthy relevant prior art patent to Morgan of Monsanto, U.S. Pat. 3,414,645.

At trial before ITC administrative law judge Paul Luckern, the Dutch companies argued strenuously anticipation, as they had done overseas and would do, successfully, in country after country: all the process elements of claim 13 were to be found in Morgan '645: air gap spinning;

660330 954344

the inventor of claim 13 class aramid; 4,4'-DABT; spinning into cold water, and the use of a dope comprising concentrated sulphuric acid. The '645 even incorporated by reference two others patents which were highly relevant and included the aramid of choice, PPD-T. Indeed, any fair examination of claim 13 showed that it was broader than the Kevlar process and all the elements of the claim were expressly or implicitly taught by Morgan '645. DuPont countered with arguments that there was no teaching of a particular form of concentrated sulphuric acid - 98% - 100% - taught by Morgan '645, and more importantly, Morgan '645's fibers were 7gpd, only one-third the strength of Kevlar, and that Monsanto's Morgan neither appreciated the problems in the nylon prior art or the Kevlar process solution, and that one had to "pick and choose" between many elements taught in Monsanto '645 to arrive at the Kevlar process.

Akzo countered that claim 13 did not recite the Kevlar properties, that claim 13 required only 98% sulphuric acid and that the bath temperature limit was, far, far too high to ensure Kevlar (actually less than 150°C was needed), that PPD-T as an aramid was in one of the Morgan '645 incorporate references. Most importantly, the term "concentrated sulphuric acid" as that term was used in Morgan '645, and the art include 98% concentration sulphuric acid.

Unlike tribunals in England, Holland and Germany holding for Akzo on the Blades patents, ITC administrative law judge Paul Luckern held for duPont on the anticipation issue in his Initial Determination ("ID"), holding that Morgan '645 did not enable the artisan to make Kevlar, motivate him to do the same, nor place the artisan in possession of the Kevlar process in claim 13;<sup>3</sup>:

"Anticipation under 35 U.S.C. §102 requires, in a single prior art reference, disclose of each and every element of the claimed invention. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. U.S.I.T.C.*, [\*102] 718 F.2d 365, 218 U.S.P.Q. 678 (Fed. Cir. 1983). *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), cert. denied 105 S. Ct.

<sup>3</sup>

'767 claim 13 read simply as follows:

A method comprising extruding a spinning dope from an orifice through a layer of gas and into an aqueous bath at a temperature of under 50°C said dope comprising a polyamide and solvent of sulphuric acid of at least 98% concentration at a concentration of at least 40 grams of said polyamide per 100 ml. of solvent, said polyamide having an inherent viscosity of at least 3.0 and being poly(p-phenylene terephthalamide).

709 (1984) *Scott v. Inflatable Systems, Inc.*, 222 U.S.P.Q. 460, 461 (9<sup>th</sup> Cir. 1983); *In re Certain Automatic Crankpin Grinders*, 205 U.S.P.Q. 71, 76 (ITC 1984). Also to anticipate the reference must in an "enabling" disclosure, *In re Brown*, 329 F.2d 1006, 141 U.S.P.Q. 245, (C.C.P.A. 1964), i.e., a "direct teaching." As Judge I. Jack Martin stated in the Brown case, the "true test of any prior art" is whether the prior is such as to place the allegedly disclosed matter "in the possession of the public." *Id.* at 1011, 141 U.S.P.Q. at 249.

"Respondents argue the identity of claim 1 of the '756 patent, as to the polymer with the Morgan '645 patent by referring to 4,4'-DABT at col. 2, 1s 44-48 of the Morgan '645 patent and the disclosure of 4,4'DABT in the '756 patent which disclosure is within the generic concept of claim 1 of the '756 patent.

"Claim 13 of the '756 patent discloses a process involving PPD-T. Respondents argue that PPD-T is disclosed in the Morgan '645 patent by virtue of a Hill, et al. '899 patent and a Hill, et al. '511 patent (FF 295) which are referred to in column 1 of the Morgan '645 patent and which are said to disclose aromatic polyamides to be used in the Morgan '645 process. (FF 281, 282). (RPH p. 21). Respondents argue that the "slightly higher" polymer concentrations of claim 13 (at least 18 wt. percent in claim 13 as against at least 14.1 wt. percent in claim 1) are clearly disclosed in the Morgan '645 patent and therefore claim 13 cannot avoid anticipation. (RPH pp. 20-21).

•  
•  
•

"The Morgan '645 patent is further deficient as an anticipating reference under 35 U.S.C. §102 because it does not disclose a process involving sulphuric acid of "at least 98%" concentration as a solvent for the polymer. This is a limitation not only in claim 13 but in each of the claims of the '756 patent. (FF 33). Respondents argue that the use of sulphuric acid of at least 98% concentration for PPD-T is disclosed in the Morgan '645 patent by virtue of the Smith '125 patent (FF 296-298) referred to in col. 1 of the Morgan '645 patent in the recitation [\*106] in the Morgan '645 patent of concentrated sulphuric acid (FF 283). Concentrated sulphuric acid is not inherently sulphuric acid of at least 98%. For example the term concentrated sulphuric acid was used at DuPont to refer to sulphuric acid having a concentration as low as 95% (FF 158, 167). Also there is frequent reference in the literature to concentrated sulphuric acid with a concentration as low as 95%. (FF 389, 390). Concentrated sulphuric acid of at least 98% concentration is critical for the formation of the anisotropic dopes used in the processes of the Blades claims. (FF 37, 41). In neither the Morgan '645 patent nor Smith '125 patent is there a teaching of the use of sulphuric acid of at least 98% concentration for obtaining anisotropic dopes. A mere reference to concentrated sulphuric acid in the Morgan '645 patent is not a teaching of an acid of at least 98% concentration, as claimed in



*In re Arldey*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (CCPA 1972) for anticipation under 35 U.S.C. §102 a reference must clearly and unequivocally disclose the claimed subject matter or direct those skilled in the art to said matter without any need for picking, choosing and combining various disclosures not directly related to each other by the teachings of the cited art. See also *General Battery v. Gould, Inc.* 545 F. Supp. 731, 744, 215 U.S.P.Q. 1007, 1017 (D. Del. 1982), *Structural Rubber Products Co. v. Park Rubber Co. supra* 749 F.2d at 716, 723 U.S.P.Q. at 1271.

"For the foregoing reasons Respondents have not sustained their burden in proving that claim 13 of the '756 patent is invalid under 35 U.S.C. §102." (Emphasis ITC and supplied).

Initial determination, 337-TA-194, May 9, 1985 (1990 ITC Lexus 266). It was a short leap for Judge Luckern to leap from non-anticipatory to non-obviousness, as well. The Commission affirmed ITC ALJ Luckern, and the Federal Circuit affirmed the ITC, Akzo N.V. v. International Trade Commission, 808 F.2d 1471, 1479 (Fed. Cir. 1986): " We understand that opinion as simply finding that the prior art [Monsanto] referenced did not disclose to one of ordinary skill in the art the [Kevlar] process for making the aramid process of claim 13".

*The In re Aramid Fibers / Akzo N.V. v. ITC case holds for the proposition that where an alleged process publication disclosing parts of an applicant's process fails to provide one of ordinary skill in the art (a) the motivation to choose between its teachings the elements to perform applicants' process invention, and (b) does not disclose applicants' surprising results, the reference is nonenabling under 35 U.S.C. §112 and cannot be deemed as placing one of ordinary skill in possession of the claimed process invention, and is non-anticipatory and further does not render the claimed process invention obvious. Reissue applicants submit it is the law in this country. As the '025 patent application does not teach the problems of WIMS, nor the solutions, and does not even incorporate by reference the WIMS patent, its pithy process teachings, it falls within the scope of In re Aramid Fibers and the Akzo N.V. case.*

VI.

**Claims 7-8, 21, 26-27 and 39-41 Are Not Obvious in View of DeMoore**

Absent a teaching of the problems of the prior art to be overcome absent a teaching of the benefits of applicants' process, and absent incorporation of WIMS '976, the very best that can be said of the pithy process elements purportedly disclosed in EP 741,025 and Ser. No. 08/435,798 is that it made an incomplete suggestion to the artisan to try flexography first. We say "best", because the problems behind the '363 invention were not disclosed, the surprising results and applicants' achievements were not disclosed, the WIMS patent was not incorporated, there was no motivation for the artisan to try the process, and last but not least, flexography and offset lithography were separate (and distant) printing arts in 1995.

"As of 1991, I do not recall flexographic applications existing in the offset lithographic art other than end-of-process applications. The arts were different. Flexography was used in the manufacture of boxes, bags and labels."

Bird Decl. ¶6. *Reissue applicants contend their process was not even obvious to try in view of DeMoore '025.* But "obvious to try" is not the law in this county. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 1529 (Fed. Cir. 1988); In re Merck & Co., 800 F.2s 1091, 1097, 231 USPQ 375 (Fed. Cir. 1986). The "obvious to try" doctrine encompasses those situations such as this one - where, at best, suggestions are made "to explore a new technology or general approval that [seems] to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." In re O'Farrell, 853 F.2d 894 7 U.S.P.Q. 1673, 1680 (Fed. Cir 1988), citing Dow above. There is no evidence from the '025 application that DeMoore recognized that putting the flexography step first would solve the problems described by reissue applicants. Note, In re Antonie, 559 F.2d 618, 195 U.S.P.Q. 6,8 (C.C.P.A. 1977).

Absent a teaching of the advantage of applicants' claimed invention and absent a teaching of the WIMS process, the artisan had little, if any, motivation to go to the expense and move a cantilevered add-on flexography unit forward in an offset lithography press in 1995 or modify

660340 9445760

an existing rack-back to do the same thing. "In hindsight, the only people anywhere in the world which have the motivation in 1994-5 to go 'upstream' with flexography in an offset / lithograph press would be a printer or manufacturer of inks or coatings, probably metallic inks or coatings."

**Memorandum Exhibit B**, Bird Decl, ¶6. See also Supplemental Declaration of Prince, ¶¶11(6) and 11(7), **Exhibit A** supra. "Selective hindsight is no more applicable to the design of experiments than it is to the [improper] combination of prior art teachings". Id. Even more, were the '025 prior art, which it is not, reissue applicants achieved surprising results.

## VII.

### Claims 42-87 Are Not Obvious in View of DeMoore EP 741,025

For the reasons given above, and for the fact that DeMoore teaches overprinting, not perfection, reissue applicants' claims 42-87 are also free of DeMoore. Note: Supplemental Decl. of Prince, ¶¶11(1)-11(7), **Exhibit A** hereto.


### CONCLUSION

All of the suggested changes to the specification and claims have been made by reissue applicants to put the claims in immediate condition for allowance. The evidence is clear from the combination of sworn testimony of Baker, Bird, Brown and Garner that DeMoore derived whatever elements of reissue applicants' claimed invention from reissue applicants in July 1994, that reissue applicants simulated the invention in January 1995 - March 1995, that neither EP 741,025 (A2)/(A3) or their U.S. priority document can or should be relied on as prior art, and that the teaching of EP 741,025A2 toward reissue applicants' claimed process is so deficient as to be non-enabling and second, at best, obvious to try.



Claims 1-87 are allowable and a paper to that effect would be appreciated.

Respectfully submitted,



Robert Hardy Falk

Reg. No. 27,877

**FALK & FISH, l.l.p.**

P.O Box 794748

Dallas, Texas 75397

Telephone: (214) 954-4480

Facsimile: (214) 969-5941

660259 96/5760

  
Robert Hardy Falk

8

8

8

8

2

2

3

8

8

29

2

5

5

8

8

g

2

2

1/TRANSMITTAL LETTER

for  
amatt "a"


for  
amatt "a"

for  
amatt "a"

- for  
amatt "a"

for  
amatt "a"

~~Respectfully submitted,~~

  
Robert H. Falk  
Reg. No. 27,877

Robert H. Falk  
Reg. No. 27,877  
**FALK & FISH, L.L.P.**  
P.O. Box 794748  
Dallas, Texas 75397  
Telephone: (214) 954-4480  
Facsimile: (214) 969-5941

Robert H. Falk  
Reg. No. 27,877  
**FALK & FISH, L.L.P.**  
P.O. Box 794748  
Dallas, Texas 75397  
Telephone: (214) 954-4480  
Facsimile: (214) 969-5941

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:

**BILL L. DAVIS and JESSE S. WILLIAMSON**

For Reissue of U. S. Patent 5,630,363

Issued May 20, 1997

Serial No. 08/515,097

Filing Date: May 20, 1999

Serial No.: 09/315,796

For: **COMBINED LITHOGRAPHIC/  
FLEXOGRAPHIC PRINTING  
APPARATUS AND PROCESS**



Group Art Unit: 2854

Examiner: S. Funk  
J. Hilten

**AMENDMENT UNDER 37 CFR §1.111 TRANSMITTAL LETTER**

TO: Honorable Commissioner of Patents and Trademarks  
Washington, D.C. 20231

SIR:

	<u>NO. FILED</u>	<u>AFTER THIS AMENDMENT</u>	<u>EXTRA</u>	<u>FEE DUE</u>
Reissue Independent Claims Over 20 in Patent, Fee Code 109	13	14	1	\$78
Reissue Claims in Excess of 20	46	46	0	0
Multiple Dependent	2	2	0	0
				<hr/> \$78

- ☒ A check in the amount of \$78.00 is attached.
- ☒ Please change any additional fees or credit any overpayment to Deposit Account No. 06-0075.

A duplicate copy of this letter is attached.

**RECEIVED**

APR 1 2000

TECHNOLOGY CENTER 2800

Respectfully submitted,

  
Robert H. Falk

Reg. No. 27,877

**FALK & FISH, L.L.P.**

P.O. Box 794748

Dallas, Texas 75397

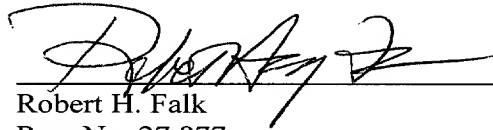
Telephone: (214) 954-4480

Facsimile: (214) 969-5941

ATTORNEY FOR REISSUE APPLICANTS

CAV 2854/1

Respectfully submitted,



Robert H. Falk

Reg. No. 27,877

**FALK & FISH, L.L.P.**

P.O. Box 794748

Dallas, Texas 75397

Telephone: (214) 954-4480

Facsimile: (214) 969-5941

ATTORNEY FOR REISSUE APPLICANTS

060750 944748